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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,925	03/31/2004	Sumit Agarwal	Google-66 (GP-238-00-US)	5061
82402	7590	02/02/2009	EXAMINER	
Straub & Pokotylo 788 Shrewsbury Avenue Tinton Falls, NJ 07724			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,925	<b>Applicant(s)</b> AGARWAL ET AL.	
	<b>Examiner</b> Yehdega Retta	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/07, 4/30/08, 11/03/08, 12/19/08</u> .                    | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claims 32-72 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statute, the claimed invention must fall into one of four recognized statutory classes on invention, namely, a process (or method), a machine (or system); an

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article of manufacture; or a composition of matter. Claim 32 is not directed to a process, as there are no method steps; it is not directed to a system, as there are no system components; it is not directed to composition of matter, as there are not chemical compounds. Computer program code or signal not claimed as embodied in computer executable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. Such claimed computer program, code or carrier wave signal does not define structural and functional interrelationships between the signal and other claimed elements of the invention, which permit the data signal's functionality to be realized (see MPEP section 2106). Since there is no composition of matters or system components claimed to render the claims statutory, the claims are rejected as being directed to a non-statutory matter (see MPEP section 2106). Claim 37 are also rejected for the same reason.

Claims 42 and 50 recited an input and also means for obtaining terms or phrases and means for providing can be performed through software only, the claims are therefore rejected as program or code per se. Claim 58 is also rejected for the same reason.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites wherein the act of using the

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accepted document identifier to obtain the term or phrase uses information which stores aggregated association of search query information to ... It is unclear how the act of using the accepted document or the act of obtaining the term or phrase uses information how can an information store aggregated association. It is unclear what the relationship is between the act of accepting or obtaining and the information. It is also unclear if applicant means by "information which stores aggregated association of search query information to selected documents". Claim 5 also recites wherein the act of providing includes populating keyword targeting information of the ad. It is unclear if the populating of keyword is additional step or is part of the providing keyword or term. If it is part of the providing, it is unclear how the act of providing can do the population.

Claims 6-8, 12-16, 28-31, 45-49, 53-57, 69-72 are also rejected for the same reason stated above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Paine et al. (US 7,225,182 B2).

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Regarding claims 1-3, 9-11, 32-36, 42-44, 50-52, Ryan teaches accepting a document identifier; using the accepted document identifier to obtain at least one of one or more terms and one or more phrases; and providing the obtained at least one of one or more terms phrases as ad information for an ad, wherein the ad has a landing page document, and wherein the landing page document corresponds to a document identified by the document identifier; wherein the document is a Web page; wherein the document identifier is a universal resource locator (see fig. 15-23). The claim indicates that the term or phrase is provided as ad information for and ad which is just the intended use of the term or phrase. Examiner would like to point out that no patentable weight is given to languages that only provide the intended use.

Regarding claims 4-8, 12-16, 45-49, 53-57 Ryan teaches aggregated associations of search query to selected content; populating keyword targeting information of the ad; populating at least some content of a creative of the ad; suggesting at least some content of a creative of the ad to an advertiser (col. 2 lines 25-56, col. 4 lines 43-67, col. 11 line 6 to col. 12 line 67).

Regarding claims 17-27, 58-61, 67-68, Ryan teaches storing, in response to a selection of a search result generated by a search query, and corresponding to a linked document, an association of information of the linked document and information of the search query; aggregating stored associations of information of documents and information of search queries to generate aggregated document information to search query information associations; storing the aggregated document information to search query information associations; wherein the information of the linked document is a

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document identifier; wherein the document is a Web page or universal resource locator (see col. 6 line 10 to col. 8 line 40, Table 1-3). Claim 25 indicates that the term or phrase is provided as ad information for and ad which is just the intended use of the term or phrase. Examiner would like to point out that no patentable weight is given to languages that only provide the intended use.

Regarding claims 28-31, 62-65, 69-72, Ryan teaches aggregated associations of search query to selected content; populating keyword targeting information of the ad; populating at least some content of a creative of the ad; suggesting at least some content of a creative of the ad to an advertiser (col. 2 lines 25-56, col. 4 lines 43-67, col. 11 line 6 to col. 12 line 67).

Regarding claims 32-41, Ryan teaches a plurality of entries, each of the plurality of entries including a first field for storing a document identifier, and ii) a second field for storing at least one of one or more terms, one or more phrases and term and term count; wherein the document identifier stored in the first field corresponds to a document selected from a search result list generated by a search query, and at least one of one or more terms and one or more phrases stored in the second field was included in the search query; wherein the document is a Web page; wherein the document identifier is a universal resource locator; wherein the document is a home page of a Website (see Table 1-3 and col. 11 line 19 to col. 13 line 30). Examiner would like to point out that the claim only recites a data structure comprising of entries. No patentable weight should be given to the content of the entries since there is no patentable difference between having one type of field or another in entries.



Regarding claim 66, Ryan teaches an input for accepting a document identifier; e) means for obtaining at least one of one or more terms and one or more phrases from the stored aggregated document information to search query information associations, using the accepted document identifier; and f) means for providing the obtained at least one of (A) one or more terms and (B) one or more phrases as ad information for an ad, wherein the ad has a landing page document, and wherein the landing page document corresponds to a document identified by the document identifier (see col. 6 line 10 to col. 8 line 40, Table 1-3). The claim recites that the term or phrase is provided as ad information for and ad which is just the intended use of the term or phrase. Examiner would like to point out that no patentable weight is given to languages that only provide the intended use.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Paine (US 7,225,182) teaches recommending search terms using collaborative filtering and we spidering.

Kravets (US 6,704,727) teaches generating a set of search terms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622